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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09 760,950 | 01/15/2001 | Enchi Uriu | YAMAP0347USD | 5487 |

7590 08/12/2003
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EXAMINER

NGUYEN, TUYEN T

ART UNIT PAPER NUMBER

2852

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/760,950

Applicant(s)

Uriu et al.

Examiner
Tuyen T. Nguyen

Art Unit
2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 22, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tashiro et al. [US 5,515,022] in view of Hirohashi [JP 6-112047].

Tashiro et al. discloses a multi-layered chip inductor [1] comprising:

- at least one conductive pattern [31, 32] having a thickness of 10 micro-meters or more and a width to thickness ratio from 1 to less than 5 [see column 6, lines 12-25];
- at least one pair of insulating layers [22, 23] formed of magnetic material sandwiching the conductive pattern; and
- a thick conductor [35] connecting the conductive pattern.

Tashiro et al. discloses the instant claimed invention except for the inductor component being formed of a ceramic material.

Hirohashi discloses a ceramic chip inductor.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the inductor component of Tashiro et al. with a ceramic material, as suggested by Hirohashi, for the purpose of controlling the frequency response.

Response to Arguments

3. Applicant's arguments filed 5/22/03 have been fully considered but they are not persuasive.

Applicant argues that:

[1] The examiner fails to identify where in either of reference there is any teaching or suggestion that the insulating layers are actually in contact with the conductor pattern;

[2] The specific method used by the references to form the conductor pattern preclude the insulating layer to be in contact, as claimed;

[3] Tashiro and Hirohashi do not teach or suggest the claimed invention in relation to the thickness of 10 micrometer or more and width to thickness ratio 1 to less than 5;

[4] The electroforming process necessarily resulted in the formation of the product which differs from the prior art product which are made by a different process; and

[5] The declaration shows that Tashiro cannot meet the claimed thickness and ratio.

The examiner disagrees.

Regarding [1], Tashiro discloses the insulating layers in contact with the conductor pattern [figure 2].

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Regarding [2], applicant claims do not preclude a gap between the insulating layers in the area that is not in contact with the conductor.

Regarding [3], Tashiro discloses the width to thickness ratio, as claimed.

Regarding [4], Tashiro in view of Hirohashi discloses the product, as claimed.

Regarding [5], applicant has failed to provide sufficient proof and evidence of experimentation to show that Tashiro does not show the claimed thickness to width ratio.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tuyen T. Nguyen whose telephone number is (703) 308-0821.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Elvin Enad, can be reached at (703) 308-7619. The fax number for this Group are (703) 308-7722 and (703) 308-7724.

Any inquiry of a general nature or relating to status of this application of proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

TTN *TTN*

August 10, 2003

Truyen Nguyen